

#11
CD

CERTIFICATE OF MAILING

I hereby certify that this document is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on November 25, 2002.

Elizabeth Miller
Elizabeth. Miller

11/25/2002
Date

ATTY DOCKET No. 10010760-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Glenda C. Delenstarr et al. Group Art Unit: 1634

Serial No.: 09/899,381

Examiner: Bradley L. Sisson

Filed: 07/02/2001

Title: ARRAYS HAVING BACKGROUND FEATURES AND METHODS
FOR USING THE SAME

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

RECEIVED

DEC 04 2002

TECH CENTER 1600/2900

RESPONSE TO RESTRICTION

The Examiner is thanked for the Office Action mailed 10/24/02 (restriction requirement only). This Action follows a previous restriction requirement in the Action mailed 09/03/2002 in order to include the kit claims in the restriction. The Examiner has now identified the following Groups:

Group I: claims 1-12 for an array, and claims 24-27 for a kit; and
Group II: claims 13-23 for a method.

Applicants continue to elect Group II (claims 13-23) with traverse. In particular, M.P.E.P 803 requires that

“If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.”

In the present case the only independent claim in Group II is claim 13. This claim is a method claim which requires in part:

- “(a) providing a nucleic acid array comprising:
 - (i) at least one hybridization feature to which said analyte nucleic acid specifically binds under stringent hybridization conditions; and
 - (ii) at least one background feature,” (emphasis added)

The broadest claim of the array claims 1-12 of Group I, namely claim 1, recites an array comprising:

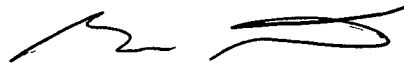
- “(a) at least one hybridization feature; and
- (b) at least one background feature”

Claim 13 (the only independent claim of Group II) then requires providing an array of the type of claim 1. Thus, in order to search and examine claims of the type of Group II the Examiner must necessarily search and examine claims of a type of Group I. That being the case, there is no “serious burden” on the Examiner in searching and examining Group I together with Group II.

Similarly, with regard to the kit claims 24-27 the only independent claim of these claims also requires a kit having the elements of claim 1. Thus, there is again no “serious burden” on the Examiner in searching and examining these claims together with those of Groups II.

If the Examiner is of the view that there are any outstanding issues that might be resolved by means of a telephone conference, he is invited to call Gordon Stewart at (650)485-2386.

Respectfully submitted,



Gordon M. Stewart
Attorney for Applicants
Reg. No. 30,528

Agilent Technologies, Inc.
Legal Department, DL429
IP Administration
P.O. Box 7599
Loveland, CO 80537-0599

10010760-1 2nd Resp (Restn)